

Office Action Summary

Application No.

10/698,424

Applicant(s)

JOHNSON ET AL.

Examiner

Keith O. Robinson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 16-19, and 24, drawn to an alfalfa variety with fast recovery after spring green-up or after harvest, classified in class 800, subclass 298, for example.
- II. Claims 5-14, 16-19, and 24, drawn to an alfalfa variety having more erect stems at late bloom, classified in class 800, subclass 298, for example.
- III. Claim 15, drawn to an alfalfa variety with fast recovery after spring green-up or after harvest and more erect stems at late bloom, classified in class 800, subclass 298, for example.
- IV. Claims 20 and 25, drawn to alfalfa germplasm 'CW 75046' and a tissue culture thereof, classified in class 800, subclass 268, for example.
- V. Claims 21 and 26, drawn to alfalfa germplasm 'CW 83201' and a tissue culture thereof, classified in class 800, subclass 268, for example.
- VI. Claims 22 and 27, drawn to alfalfa germplasm 'CW 85029' and a tissue culture thereof, classified in class 800, subclass 268, for example.
- VII. Claims 23 and 28, drawn to alfalfa germplasm 'CW 95026' and a tissue culture thereof, classified in class 800, subclass 268, for example.
- VIII. Claim 29, drawn to an alfalfa variety having high yield, persistence, multiple pest resistance, fast recovery after winter, improved standability,

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and fast recovery after spring green-up or after harvest, classified in class 800, subclass 298, for example.

The inventions are distinct, each from the other because:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different

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phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions I and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions I and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions I and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different genetic, morphological, and/or physiological backgrounds with each invention having a separate and distinct derivation.

Inventions I and VIII are unrelated. Inventions are unrelated if it can be

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shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions II and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different

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phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions II and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions II and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions II and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions III and IV are unrelated. Inventions are unrelated if it can be

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shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions III and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions III and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions III and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different

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phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions III and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different because each invention is a separate and unique alfalfa germplasm having a unique genetic background that is different from that of any other alfalfa germplasm.

Inventions IV and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different because each invention is a separate and unique alfalfa germplasm having a unique genetic background that is different from that of any other alfalfa germplasm.

Inventions IV and VII are unrelated. Inventions are unrelated if it can be

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shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different because each invention is a separate and unique alfalfa germplasm having a unique genetic background that is different from that of any other alfalfa germplasm.

Inventions IV and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different because each invention is a separate and unique alfalfa germplasm having a unique genetic background that is different from that of any other alfalfa germplasm.

Inventions V and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different because each invention is a separate and

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unique alfalfa germplasm having a unique genetic background that is different from that of any other alfalfa germplasm.

Inventions V and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different because each invention is a separate and unique alfalfa germplasm having a unique genetic background that is different from that of any other alfalfa germplasm.

Inventions VI and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Inventions VII and VIII are unrelated. Inventions are unrelated if it can be

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shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). These inventions are different due to each invention having different phenotypic traits that would be controlled by different genes thus giving each invention a different genetic background.

Because the inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.



ASHWIN D. MEHTA, PH.D.
PRIMARY EXAMINER

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, Ph.D. can be reached on 571-272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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